



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/339,733      | 06/24/1999  | SCOTT C. COTTRILLE   | 777.209US1          | 2967             |

26389 7590 09/05/2002

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC  
1420 FIFTH AVENUE  
SUITE 2800  
SEATTLE, WA 98101-2347

EXAMINER

ROMERO, ALMARI C

ART UNIT PAPER NUMBER

2176

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/339,733

Applicant(s)

COTTRILLE ET AL.

Examiner

Almari Romero

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is responsive to communications: Application filed on 6/24/99 and Preliminary Amendment filed on 6/24/99.
2. Claims 1-28 are pending in the case. Claims 1, 10, 22, 23, 24, and 25 are independent claims.

#### ***Drawings***

3. The formal drawings filed on 6/24/99 were approved by the Draftsperson.

#### ***Information Disclosure Statement***

4. The references "Beyond Browsing: Shared Comments, SOAPs, Trails, and On-line Communities", "Pan-Browser Support for Annotations and Other Meta-Information on the World Wide Web", and "Tools for Collaborative Learning" listed in the Information Disclosure Statement filed on 6/24/99 have been a considered, however, all other documents related to "Alexa 3.0 – Quick Tour" and "A Protocol for Scalable Group and Public Annotations" fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, **date**, and place of publication. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the

Art Unit: 2176

time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### *Specification*

5. The abstract of the disclosure is objected to because applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities:

On page 1, "Cross References" section of the specification, page 11, lines 29-30, and page 16, line 30 – page 17, line 2, Applicant is reminded to insert related applications serial numbers and the status of each application, if allowed or in patent prosecution.

Appropriate correction is required.

7. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. For example on page 29, line 9 and line 24; page 30, line 30; page 31, line 16; page 33, line 3; and page 34, line 4. Applicant is suggested to add left and right brackets or quotations marks on each side of hyperlink to deactivate hyperlink or Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff (USPN 5,822,539 - filed on 12/08/1995) in view of deVries et al. (USPN 6,332,144 B1 - filed on 12/03/1998).**

**Regarding independent claim 1, van Hoff discloses:**

A computing system for managing annotations, the computing system comprising:

a tier III server to store data for the annotations (van Hoff on col. 4, lines 22-37: teaches annotation proxy server 118 stores data of annotations to be annotated on document);

a tier I server to determine if a content source has data indexed by the tier II server (van Hoff on col. 6, lines 34-57: teaches server 104 providing the requested document to proxy server 118 to apply identified annotation.

However, van Hoff does not explicitly disclose, “a tier II server to maintain an index of the data for the annotations stored on the tier III server”.

deVries et al. (deVries) on col. 7, lines 19-67: teaches index database server maintains an index database with an index of annotation data for query match.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into van Hoff to provide a server maintaining index database with an index of annotation data for annotations stored on proxy server 118 to be retrieved and annotated on a document in order to provide an efficient searching, browsing, and retrieving annotating media in a data processing network environment.

**Regarding dependent claim 2**, deVries discloses:

wherein the tier II server further stores a plurality of generic properties for the annotations (deVries on col. 2, lines 52-57: teaches annotation index with annotations values, identified times and probabilities).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into van Hoff to provide a server maintaining index database with an index of annotation data for annotations stored on proxy server 118 to be retrieved and annotated on a document in order to provide an efficient searching, browsing, and retrieving annotating media in a data processing network environment.

**Regarding dependent claim 3**, van Hoff discloses:

wherein the tier III server further stores one or more type specific properties for the annotations (van Hoff on col. 6, lines 27045: teaches identify name or number of annotation).

**Regarding dependent claims 4-6**, van Hoff discloses:

wherein the tier I, II, III server comprises a plurality of servers (van Hoff on col. 4, lines 22-37 and lines 57-62: teaches plurality of servers).

**Regarding dependent claim 8**, van Hoff discloses:

wherein the content source is identified by a document identifier (van Hoff on col. 5, lines 1-26: teaches document identifier).

**Regarding dependent claim 9**, van Hoff discloses:

wherein the document identifier is selected from the group consisting of: a directory path, a uniform resource locator, and a file name (van Hoff on col. 5, lines 1-26: teaches document identifier is URL).

**Regarding independent claim 10**, van Hoff discloses:

A computerized method of posting an annotation, the method comprising:

sending an annotation post from a client to a tier III server (van Hoff on col. 6, lines 34-57: teaches client requesting document with annotations);

storing a portion of the annotation on the tier III server (van Hoff on col. 6, lines 34-57: teaches APS server with stored annotation data);

sending a second portion of the annotation from the tier III server to a tier II server (van Hoff on col. 8, lines 64-66: teaches relevance information field about annotation);

storing the association information on the tier I server (van Hoff on col. 5, lines 1-26: teaches storing information associated with annotation such as a unique document identifier).

However, van Hoff does not explicitly disclose, “storing the second portion of the annotation on the tier II server and sending association information from the tier II server to a tier I server”.

deVries on col. 7, lines 19-67: teaches stored portion of a digital representation (annotation) and sending matched identification number to the librarian 28).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into van Hoff to provide a way to store portion of a digital representation such as annotations to send an identifier to server 104 in order to allow the flexibility in searching, browsing, and retrieving of annotations in a communication network environment.

**Regarding dependent claim 11**, van Hoff discloses:

wherein the acts are performed in the order listed (van Hoff on col. 3, lines 11-21: teaches procedure for merging supplement information to associated document).

**Regarding dependent claims 12-15**, van Hoff discloses:

further comprising notifying the client and tier II, III servers (van Hoff on col. 6, lines 5-32: teaches client in communication with a plurality of servers and server connected to a server for communication).

**Regarding dependent claim 16**, van Hoff discloses:

wherein sending the annotation post from the client to the tier III server comprises sending a URL for the tier I server, a URL for the tier II server, a URL for the tier III server, a context document identifier, type specific annotation properties, generic annotation properties, and an annotation body (van Hoff on col. 5, lines 1-26: teaches URL identifies location of a particular server among a plurality of different servers).

**Regarding dependent claim 17**, van Hoff discloses:



wherein storing a portion of the annotation on the tier III server comprises storing the annotation body and the type specific annotation properties (van Hoff on col. 6, lines 34-57: teaches storing data of annotations and col. 8, lines 4-29: teaches types of annotations).

**Regarding dependent claim 18**, van Hoff discloses:

further comprising generating a unique identifier for the annotation body and type specific annotation properties stored on the tier III server (van Hoff on col. 6, lines 34-57: teaches generating unique document identifier).

**Regarding dependent claim 19**, van Hoff discloses:

wherein sending a second portion of the annotation to the tier II server comprises sending a URL or the tier I server, a URL for the tier II server, a URL for the tier III server, a context document identifier, generic annotation properties, and the unique identifier (van Hoff on col. 5, lines 1-26: teaches URL for identifying locations of plurality of servers containing stored annotations).

**Regarding dependent claim 20**, deVries discloses:

wherein storing the second portion of the annotation on the tier II server comprises storing the generic annotation properties, the URL for the tier III server, and the unique identifier (deVries on col. 7, lines 19-67: teaches stored portion of a digital representation (annotation)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into van Hoff to provide a way to store portion of a digital representation such as annotations to send an identifier to server 104 in order to allow the flexibility in searching, browsing, and retrieving of annotations in a communication network environment.

**Regarding dependent claim 21, van Hoff discloses:**

wherein sending association information to the tier I server comprises sending the tier I server URL, the tier II server URL, the context document identifier and an indexing identifier storing the association information on the tier I server (van Hoff on col. 5, lines 1-26: teaches storing information associated with annotation such as a unique document identifier).

**Regarding independent claims 22 and 23, van Hoff discloses:**

A computer-readable medium having stored thereon a "client-to-tier III server" data structure comprising:

a first field containing data representing a context document identifier (van Hoff on col. 5, lines 1-26: teaches document identifier);

a second field containing data representing a body of the annotation (van Hoff on col. 6, lines 34-57: teaches storing data of annotations and col. 8, lines 4-29: teaches types of annotations);

a fourth field containing data representing type specific properties of the annotation (van Hoff on col. 6, lines 27-45: teaches identify name or number of annotation);

a fifth field containing data representing a URL for a tier III server for receiving and storing a portion of the post of the annotation (van Hoff on col. 6, lines 5-18: teaches URL for annotation proxy server);

a seventh field containing data representing a URL for a tier I server for receiving and storing associations for the annotation (van Hoff on col. 5, lines 1-26: teaches URL for server 104).

However, van Hoff does not explicitly disclose, “third field containing data representing generic properties of the annotation and a sixth field containing data representing a URL for a tier II server for receiving and storing a portion of the post of the annotation”.

deVries on col. 2, lines 52-57: teaches annotation index with annotations values, identified times and probabilities and on col. 7, lines 19-67: teaches stored portion of a digital representation (annotation)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into van Hoff to provide a way to store portion of a digital representation such as annotations to send an identifier to server 104 in order to allow the flexibility in searching, browsing, and retrieving of annotations in a communication network environment.

**Regarding independent claim 24**, van Hoff discloses:

A computer-readable medium having stored thereon a "tier II server-to-tier I" server data structure comprising:

a first field containing data representing a context document identifier (van Hoff on col. 5, lines 1-26: teaches document identifier);

a fourth field containing data representing a URL for a tier I server for receiving and storing associations for the annotation (van Hoff on col. 5, lines 1-26: teaches URL for server 104).

However, van Hoff does not explicitly disclose, “a second field containing data representing an indexing identifier of the annotation and a third field containing data representing a URL for a tier II server for indexing the annotation”.

deVries on col. 7, lines 19-67: teaches index database server maintains an index database with an index of annotation data.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into van Hoff to provide a server maintaining index database with an index of annotation data for annotations stored on proxy server 118 to be retrieved and annotated on a document in order to provide an efficient searching, browsing, and retrieving annotating media in a data processing network environment.

**Regarding independent claim 25**, van Hoff discloses:

A computerized method for managing annotations, the method comprising:

storing within a tier I server a plurality of associations with references to a tier II server for each association (van Hoff on col. 5, lines 1-26: teaches storing information associated with annotation);

storing within a tier III server content for each one of the annotations (van Hoff on col. 4, lines 22-37: teaches annotation proxy server 118 stores data of annotations to be annotated on document);

receiving by the tier I server from a client a context document identifier (van Hoff on col. 5, lines 1-26: teaches receiving from client a URL for identifying locations of plurality of servers containing stored annotations); and

providing a first response to the client from the tier I server, wherein the first response comprises one for more associations for the context document identifier and the reference to the tier II server for each one of the associations (van Hoff on col. 5, lines 1-26: teaches client in

communication with servers and providing URL that identifies location of a particular server among a plurality of different servers.

However, van Hoff does not explicitly disclose, “storing within a tier II server an indexing identifier for each one of the annotations and storing within the tier II server a reference to a tier III server for each one of the annotations”.

deVries on col. 7, lines 19-67: teaches index database server maintains an index database with stored index of annotation data.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into van Hoff to provide a server maintaining index database with an index of annotation data for annotations stored on proxy server 118 to be retrieved and annotated on a document in order to provide an efficient searching, browsing, and retrieving annotation data in a data processing network environment.

**Regarding dependent claims 26,** van Hoff discloses:

further comprising: receiving by the tier II server from the client a selection identifying one of the associations for the context document identifier; providing a second response to the client from the tier II server, wherein the second response comprises a header for each one of the annotations associated with the context document identifier and the reference to the tier III server for each one of the annotations (van Hoff on col. 5, lines 1-26 and col. 6, lines 5-32: teaches client in communication with a plurality of servers and providing URL that identifies location of a particular server among a plurality of different servers to identify annotations requested by client).

**Regarding dependent claim 27,** van Hoff discloses:

further comprising: receiving by the tier III server from the client an annotation identifier; and providing a third response to the client from the tier III server, wherein the third response comprises a body for the annotation identified by the annotation identifier (van Hoff on col. 5, lines 1-26 and on col. 6, lines 5-32: teaches client in communication with a plurality of servers and providing a portion of annotation data to the user identified by the URL).

**Regarding dependent claim 28**, van Hoff discloses:

wherein the context document identifier is selected from the group consisting of: a uniform resource locator, a file name, and a directory path (van Hoff on col. 5, lines 1-26: teaches document identifier is URL).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,020,884 (filed on 8/18/1998) - MacNaughton et al.

USPN 6,094,675 (filed on 8/04/1997) – Sunaga et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Romero whose telephone number is (703) 305-5945. The examiner can normally be reached on Mondays - Fridays (7:30am - 4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

AR  
August 22, 2002

  
HEATHER R. HERNDON  
PATENT EXAMINER  
CENTER 2100